

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

In re \_\_\_\_\_

Decision on  
Petition for Regrade  
Under 37 C.F.R. § 10.7(c)

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**JAN 19 2000**  
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**MEMORANDUM AND ORDER**

(Petitioner) petitions for regrading his answers to questions 1, 4, 25 and 43 of the morning session and questions 24, 33, and 38 of the afternoon session of the Registration Examination held on April 21, 1999. The petition is denied to the extent Petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 63. On August 2, 1999, Petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

**OPINION**

Under 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions state: "No points will be awarded for incorrect

answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is “All of the above,” the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO,” “PTO,” or “Office” are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of Petitioner’s arguments have been considered. Each question in the examination is worth one point.

Petitioner has been awarded points for morning questions 20, 27, 43, and 45 and afternoon questions 28 and 38 because these questions have been eliminated from the examination. Accordingly, Petitioner has been granted an additional six points on the examination, resulting in a regraded score of 69. However, no credit has been awarded for morning questions 1, 4 and 25 and afternoon questions 24 and 33.

Morning question 1 reads as follows:

1. P, a registered patent practitioner, filed a reply to a first Office action which rejected all claims under 35 U.S.C. § 102(a) based on an earlier patent granted to Z. The Office Action was dated September 15, 1998 and set a three month shortened statutory period for reply. P's unsigned reply, filed February 3, 1999, did not include a petition for an extension of time and contained only the following paragraph:

Applicant respectfully spits on the ludicrous position taken by the Examiner in rejecting all claims under 35 U.S.C. § 102(a) based on an invalid patent granted to Z. Applicant may be willing to overlook the Examiner's stupidity in making this rejection since it is possible that the Examiner was unaware that Z is a bum and a thief who stole Applicant's invention. Applicant has renumbered the claims and have attached a copy of Z's patent with notations made thereon. Applicant respectfully requests that the Examiner "WAKE UP" and take another look at Applicant's claims in light of those remarks. Please charge my deposit account number 99-1234 to cover the cost of any required fees.

P should not be surprised when the amendment is not entered because:

- (A) The reply was not signed.
- (B) An amendatory paper determined to contain objectionable remarks will be returned to sender.
- (C) P did not file a petition for an extension of time.
- (D) (A) and (B) are correct.
- (E) (A), (B) and (C) are correct.

Choice (D) is correct because both choices (A) and (B) are correct. A reply that is not signed is not entered, but applicant is given an opportunity to ratify the reply. See Manual of Patent Examining Procedure (MPEP) § 714.01(a). A reply determined to contain objectionable marks will be returned. See 37 CFR § 1.3. Choice (C) is not correct because a general authorization to charge a deposit account is a request for an extension of time, albeit an unsigned one in this instance. See 37 CFR § 1.136(a)(3).

Petitioner contends that choice (E) is the correct answer because choice (C) is also correct along with choices (A) and (B). Petitioner states that an authorization to charge all required fees must be signed. Petitioner also contends P's authorization cannot serve as a constructive petition because the amendment was not entered.

Petitioner's arguments are not persuasive. The question asks why the amendment is not entered. (C) is not correct because P did file a petition for an extension of time. 37 CFR § 1.136(a) provides a statement of authorization to charge all required fees will be treated as a constructive petition for an extension of time. Since the reply contained a statement of authorization to charge any required fees, a constructive petition for the extension of time was included in the reply. Accordingly, the amendment is not entered because of the reason other than an absence of a petition for an extension of time. In the situation given, the reasons the amendment is not entered are (A) the reply was not signed and (B) the reply contains objectionable remarks. See MPEP §§ 714.19 (E) & (K) and 714.25. Choice (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on question 1 is denied.

Morning question 4 reads as follows:

4. During a reexamination proceeding, the patent owner seeks to amend Claim 1 as follows:

1.(amended) A [knife] cutting means having a handle portion and a serrated blade.

All changes in the claim are fully supported by the original patent disclosure. Should the claim, as amended, be rejected?

- (A) Yes, because the amendment broadens the scope of the claim of the patent.
- (B) No, because the claim is fully supported by the original patent disclosure.
- (C) No, because the amendment does not add new matter into the claim.
- (D) No, because the amendment narrows the scope of the patent.
- (E) Yes, because the claim has not been amended in accordance with PTO rules for amending patent claims.

The correct answer is choice (A) because the claim is broadened by changing “knife” to “cutting means.” An amended or new claims which broaden or enlarge the scope of a claim of the patent should be rejected under 35 U.S.C. § 305. MPEP § 2250. 35 U.S.C. § 305(a) sets forth “no proposed amended or new claim enlarging the scope of the claims of the patent will be permitted in a reexamination proceeding...” A claim is broader than another claim if it is broader (greater in scope) “in any respect,” even though it may be narrower in other respects. *In re Freeman*, 30 F.3d 1459, 1464, 32 USPQ2d 1444, 1447 (Fed. Cir. 1994). Even if the only disclosure of the application was a knife, “cutting means” would be construed to mean a knife any any equivalents thereof. See MPEP § 2183. Accordingly, the claim is broadened by the use of “cutting means” instead of knife.

Petitioner contents choice D is the most correct answer in certain factual situations. According to Petitioner, “[i]f the specification discloses a knife and no other cutting means, then the term ‘cutting means’ will have to be interpreted as a means-plus-function clause with the knife being the corresponding structure.” Base on this assumption, Petitioner concludes that “the substitution of the term ‘knife’ with the term ‘cutting means’ will actually result in a claim of more narrow scope.”

Petitioner’s arguments are not persuasive. Even in the narrow circumstance presented by the Petitioner, use of the term “cutting means” instead of “knife” will broaden the claim because the “means for” language defines the invention as the knife disclosed in the specification and any equivalents thereto. Moreover, if the specification disclosed a knife and a saw with a serrated edge, the use of the term “cutting means” would clearly be a broadening of the claim. Thus,

choice D is not correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 25 reads as follows:

25. Bert and Ernie are joint inventors of a widget that automatically adjusts television volume levels during commercial breaks. A nonprovisional patent application was filed on October 15, 1998, and a first Office action on the merits was mailed on January 11, 1999. A reply was filed on January 28, 1999, and a Notice of Allowance was mailed on February 26, 1999. The Issue Fee has not been paid. What is the **last day** that Bert and Ernie can file a properly drafted Information Disclosure Statement (IDS) **without** having to pay a fee and to ensure that the information submitted in the IDS would be considered by the examiner?

- (A) Friday, January 15, 1999, via facsimile with a Certificate of Transmission.
- (B) Sunday, January 10, 1999, via facsimile with a Certificate of Transmission.
- (C) Thursday, January 28, 1999, via first class mail with no Certificate of Transmission.
- (D) Friday, January 15, 1999, via "Express Mail Post Office to Post Office" with a Certificate of Express Mailing.
- (E) Thursday, February 25, 1999, via facsimile with a Certificate of Transmission but without a statement that each item cited in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to submission of the IDS.

The correct answer is choice (A) because January 15, 1999 was the latest date that Bert and Ernie can file the IDS since it was accompanied by a properly executed certificate of facsimile transmission. 37 CFR § 1.97(b) and MPEP § 609(B)(1).

Petitioner contends choice (E) is correct. According to Petitioner, "[t]he question does not provide enough information to determine which answer is the most correct." Petitioner contends that "[t]he question does not indicate whether or not the Information Disclosure Statements in A, B, C, and D included the required statement." Petitioner further maintains "[t]he question also fails to indicate the dates that the Information Disclosure Statement in questions C and D actually arrived in the USPTO."

Petitioner's arguments are not persuasive. Contrary to Petitioner's conclusion, the question does provide enough information to determine which answer is the most correct. 37 CFR § 1.97(b) sets forth "[a]n information disclosure statement shall be considered by the Office if filed by the applicant: (1) Within three months of the filing date of a national application; (2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; or (3) Before the mailing date of a first Office action on the merits, whichever event occurs last." Under this section of the rule, Bert and Ernie may file a properly drafted IDS within three months of the filing date, October 15, 1998, without filing a statement as specified in 37 CFR § 1.97(e) or the fee sets forth in 37 CFR § 1.17(p). Accordingly, January 15, 1998 is the last day that they may file the IDS. Choice (A) is the most correct answer because the IDS is timely filed in compliance with 37 CFR § 1.8(a)(1)(i)(B) and (ii), on Friday, January 15, 1998 via facsimile with a Certificate of Transmission. See also MPEP § 502.01. Choice (B) is not the correct answer because it is not the latest date. Choice (C) and (D) are also incorrect. An IDS will be considered to have been filed on the day it was received in the Office, or on an earlier date of mailing if accompanied by a properly executed certificate of mailing or facsimile transmission. Choice (C) did not include a certificate of mailing. Choice (D) used an incorrect "Express Mail" service designation. The only type of service which can be used for "Express Mail" directed to the Patent and Trademark Office is the "Post Office to Addressee" service of the U.S. Postal Service. 37 CFR § 1.10 and MPEP § 502.

Choice (E) is not correct because the fee sets forth in 37 CFR § 1.17(p) is required. 37 CFR § 1.97(c) states "[a]n information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (b) of this section, provided that the

information disclosure statement is filed before the mailing date of either a final action under § 1.113, or a notice of allowance under § 1.311, whichever occurs first, and is accompanied by either: (1) A statement as specified in paragraph (e) of this section; or (2) The fee set forth in § 1.17(p).” In choice (E), the IDS is filed without a statement as specified in 37 CFR § 1.97(e) on February 25, 1999 which is not within three months of the filing date of the application.

Therefore, the fee sets forth in 37 CFR § 1.17(p) is required. Choice (E) is not correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 24 reads as follows:

24. Which of the following statements correctly sets forth the manner in which Inventor Ann, a U.S. citizen, may file documents regarding her international patent application with the United States Receiving Office?

- (A) Where the document is the PCT international application and Ann needs to receive an April 1, 1999, filing date, Ann should file her PCT international application via first class mail with the United States Post Office and include a Certificate of Mailing dated April 1, 1999.
- (B) Where the document is a Demand for international preliminary examination, two weeks before the deadline, Ann should file her Demand by facsimile transmission with a date Certificate of Transmission.
- (C) Where the document is the PCT international application and Ann needs to receive an April 12, 1999 filing date, Ann should file a copy of her international application via facsimile transmission with a Certificate of Transmission dated April 12, 1999.
- (D) Where the documents are substituted drawing sheets due on April 15, 1999, Ann should file her substitute drawing sheets via facsimile on April 15, 1999.
- (E) All of the above.

The correct answer is choice (B). PCT international applications and papers relating to the applications are specifically excluded from the Certificate of Mailing or Transmission



procedures of 37 CFR § 1.8. Also, facsimile may not be used to file applications or drawings for PCT applications. MPEP §§ 1805 and 1834.01.

Petitioner selected choice (A) and contends that it is “equally correct with all of the other provided answers, and should be treated as the most correct answer.” Petitioner argues “all answers contain incorrect methods that are inconsistent with the policy of the USPTO.” Petitioner further maintains “[t]he adverb ‘correctly’ modifies the meaning of the question and renders the question sufficiently ambiguous in relationship to the answers, so that none of the answers meets the standards of the most correct answer.”

Petitioner’s arguments are not persuasive. Choice (A) is not “equally correct” with the choice (B). As explained in MPEP § 1805, “PCT international applications and papers relating to international applications are specifically excluded from the Certificate of Mailing or Transmission procedures under 37 CFR 1.8. This means, for example, that a Demand for international preliminary examination **cannot be filed using the Certificate of Mailing or Transmission practice under 37 CFR 1.8 if the date of mailing is the date needed for official purposes.** If 37 CFR 1.8 is improperly used, **the date to be accorded the paper will be the date of actual receipt in the Office** unless the receipt date falls on a Saturday, Sunday, or Federal holiday in which case the date of receipt will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday (37 CFR 1.6(a)(3)).” (Emphasis added). In choice (A), Ann needs to receive a filing date of April 1, 1999 for the PCT international application. If Ann files her application via first class mail with the United States Post Office and includes a Certificate of Mailing dated April 1, 1999, Ann would not receive a filing date of April 1, 1999 because the date to be

accorded the paper will be the date of actual receipt in the PTO, which would be after April 1, 1999. MPEP § 1805. Accordingly, choice (A) is not correct.

Choices (C) and (D) are not correct because PCT international applications and substituted drawing sheets cannot be filed via facsimile. MPEP § 1805 sets forth “**facsimile transmission may not be used for the filing of an international application, the filing of drawings under 37 CFR 1.437, or the filing of a copy of the international application, and the basic national fee to enter the U.S. national stage under 35 U.S.C. 371. See 37 CFR 1.6(d)(3) and (4), 1.8(a)(2)(i)(D), and 1.8(a)(2)(i)(F).**” (Emphasis added). Accordingly, choices (C) and (D) are not correct.

Choice (B) is correct because the Demand for international preliminary examination may be filed by facsimile transmission. MPEP § 1805. MPEP § 1834.01 further explains “[f]acsimile transmission may be used to submit substitute sheets (other than drawings), extensions of time, power of attorney, fee authorizations (other than the basic national fee), confirmation of precautionary designations, **Demands**, response to written opinions, oaths or declarations, petitions, and translations in international applications.” (Emphasis added). Accordingly, choice (B) is most correct because it is the only choice that complies with the PTO practice and procedure. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 33 reads as follows:

33. The claim, “An alloy consisting of 70.5 to 77.5% iron, 15.0 to 17.0% cobalt, 0.5 to 1.0% carbon, up to 2.5% chromium, and at least 7.0% tungsten” is anticipated by a reference disclosing an alloy having:

- (A) 76.0% iron, up to 15.0% cobalt, 0.5% carbon, and 8.5% tungsten.
- (B) 71% iron, 15% cobalt, 1.0% carbon, 1% chromium, 8% tungsten, and 4% nickel.

- (C) 71.3% iron, 15.2% cobalt, 0.9% carbon, 2.6% chromium, and 10% tungsten.
- (D) 76% iron, 15% cobalt, 1.0% carbon, at least 2.0% chromium, and 6% tungsten.
- (E) 72.0% iron, 16.5% cobalt, at least 2.0% carbon, 2.5% chromium, and up to 7.0% tungsten.

Choice (A) is the correct answer. The claim limitation “up to 2.5% chromium” reads on an alloy containing no chromium since “up to” requires no minimum and includes zero as a lower limit. *In re Mochel*, 176 USPQ 194 (CCPA 1974). All other elements in the claim are disclosed in the choice (A) reference. Furthermore, the amount of each element in the claim reads on the amount disclosed in the reference for each element.

Petitioner contends choice (C) is the most correct answer to the question in certain factual situations. According to the Petitioner, “[t]he meaning of the term ‘2.6% Chromium’ is unclear.” Petitioner maintains “[i]f the reference in question indicates that the uncertainty in Chromium content is greater than  $\pm 0.1\%$ , then the reference should anticipate the claim in question.” Petitioner further contends “[i]f the reference discloses a certain phase or combination of phases associated with the alloy in question, and the reference clearly indicates or even implies that there is no criticality associated with a Chromium content of 2.6%, the reference should also anticipate the claim.”

Petitioner also attacks choice (A) because “in certain factual situations the reference in answer A will not anticipate the claim.” Petitioner argues “[i]f the specification corresponding to the claim in question indicates that a certain trace amount of Chromium is required to make the invention patentably distinct, the reference in answer (A) cannot anticipate the claim.”

Petitioner’s arguments are not persuasive. Contrary to Petitioner’s position, “2.6% chromium” recited in choice (C) is not unclear. The claim limitation requires “up to 2.5% chromium,” which means the upper end point of the required range is 2.5%. In order to meet this

limitation, the reference must show an amount of chromium less than 2.5%. The reference in choice (C) shows amount of 2.6% which is more than 2.5%, falling outside of the required range. Petitioner's argument is based on facts not present, specifically the uncertainty of chromium content is greater than  $\pm 0.1\%$  or no criticality associated with a chromium content of 2.6%. The assumption of facts not present violates the Examination Directions. Furthermore, even the reference does show no criticality associated with a chromium content of 2.6%, the reference would not anticipate the claim limitation because the amount does not fall within the required range. Thus, choice (C) is not correct.

Petitioner's argument attacking choice (A) is also not persuasive. The claim limitation "up to 2.5% chromium" is met by the disclosure of 0.0% chromium. Claims are read in the light of the specification, however limitations cannot be read into the claims from the specification. Accordingly, choice (A) is the correct answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

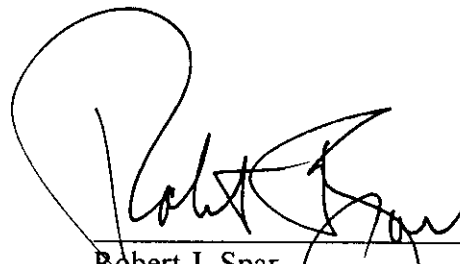
No error in grading has been shown as to questions 1, 4, and 25 of the morning session and questions 24 and 33 of the afternoon session. Petitioner's request for credit on these questions is denied.

**ORDER**

For the reasons given above, six points have been added to Petitioner's score on the Examination. Therefore, Petitioner's score is adjusted to 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Commissioner, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read "Robert J. Spar", is written over a horizontal line. The signature is stylized with a large loop at the beginning and a circular flourish at the end.

Robert J. Spar  
Director, Special Program Law Office  
Office of the Deputy Assistant Commissioner  
for Patent Policy and Projects